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10/564,314	03/16/2006	Hiroki Usui	Q92442	8039
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SUGHRUE MION, PLLC				
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WASHINGTON, DC 20037				
EXAMINER				
HAN, KWANG S				
ART UNIT		PAPER NUMBER		
1727				
NOTIFICATION DATE		DELIVERY MODE		
03/02/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/564,314

Applicant(s)

USUI ET AL.

Examiner

Kwang Han

Art Unit

1727

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,7,9,10,33 and 35-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7,9,10,33 and 35-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/20/10, 8/20/10, 10/8/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

ELECTROLYTE COMPOSITON, PHOTOELECTRIC CONVERTER AND DYE-SENSITIZED SOLAR CELL USING SAME

Examiner: K. Han SN: 10/564,314 Art Unit: 1727 February 25, 2011

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 5, 2010 has been entered. Claims 1, 6, 9, and 10 were amended.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1, 6, 9, 10, 33, and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono (JP 2003-157914, machine translation) in view of Wang et al. (J. Am. Chem. Soc. 2003, 125, 1166-1167).

Regarding claim 1, Ono is directed towards a photoelectric conversion element comprising an electrolyte composition comprising an ionic liquid (liquefied salt, electrolyte) [0024, 0025] and conductive particles containing carbon as a main component [0050, Abstract] with an electrolyte composition in the form of a gel [0051] but is silent towards forming a gel by the action of the conductive particles.

Wang teaches that photovoltaic devices with submicron sized particles including graphite particles dispersed in a high ionic strength media, form stable colloidal solutions and nanoparticles have shown to be effective as a "gelator" to solidify ionic liquids (Pg 1166, Col. 1 - Page1167, Col. 2). It would have been obvious and well within the skill of one of ordinary skill in the art to provide the conductive particles of Ono within a submicron range (nanoparticles) since Wang recognizes submicron carbon particles can act as a gelator within an ionic liquid.

Regarding claims 6 and 33, Ono discloses the conductive particle to be comprised of carbon including carbon fiber and carbon black [0050].

Regarding claims 9 and 10, Ono discloses the electrolyte to be used in an photoelectric conversion element with a semiconductor fine particle containing layer (20) which is dye sensitized, a counter electrode, and a transport layer comprised of the electrolyte (electrolyte layer) [Abstract, 0022] and conductive particles containing carbon as a main component [0050, Abstract] with an electrolyte composition in the form of a gel [0051] but is silent towards forming a gel by the action of the conductive particles.

Wang teaches that photovoltaic devices with submicron sized particles including graphite particles dispersed in a high ionic strength media, form stable colloidal solutions and nanoparticles have shown to be effective as a "gelator" to solidify ionic liquids (Pg 1166, Col. 1 - Page1167, Col. 2). It would have been obvious and well within the skill of one of ordinary skill in the art to provide the conductive particles of Ono within a submicron range (nanoparticles) since Wang recognizes submicron carbon particles can act as a gelator within an ionic liquid.

Regarding claim 35, Ono discloses the ionic liquid to be a molten salt being liquid at room temperature [0025].

Regarding claim 36, Ono discloses the fused salt to be a compound expressed by Formulas Y-a through Y-c showing quaternized nitrogen atom and an imidazole ring [0026-0031].

Regarding claim 37, Ono discloses a molten salt comprising anions selected from bis(trifluoromethylsulfonyl)imide and iodide ions [0035].

Regarding claim 38, Ono is silent towards the conductive particles having a specific resistance values but would inherently have these properties. The courts have held that claiming of a property or characteristic which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See MPEP 2112 and 2112.01. When the Examiner has provided a sound bases for believing that the products of the applicant and the prior art are the same, the burden of proof is shifted to the applicant to prove that the product shown in the prior art does not possess the characteristics of the claimed product. In *re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Regarding claim 39, Ono discloses a redox couple [0024].

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono and Wang as applied to claim 1 above and further in view of Ono.

Regarding claims 3 and 4, Ono discloses preferred ranges of the conductive particles to be in the range of 80 mass % to 2 mass % depending on the requirements of the counter electrode to supply the electrolyte. It would have been obvious to one of

ordinary skill in the art at the time of the invention to vary the content of the conductive particles since it has been held that discovering the optimum ranges for a result effective variable such as the conductive particle content involves only routine skill in the art in the absence of showing of criticality in the claimed range (MPEP 2144.05) in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

5. Claims 7 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono and Wang as applied to claim 6 above, and further in view of Smalley et al. (US 7074310).

The teachings of Ono and Wang as discussed above are herein incorporated.

Regarding claims 7 and 42, Ono teaches carbon based conductive material for a photoelectric conversion element [Abstract] but is silent towards the use of carbon nanotubes as a conductive material.

Smalley teaches single-wall carbon nanotubes can serve as elements of electronic devices such as photoelectric cell electrodes and active elements (16:2-14) with a diameter range of 0.5nm to about 3.5nm (4:4-6) and length of 80 to 200nm (26:35-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce a photoelectric element using single-wall carbon nanotubes as the conductive material because Smalley teaches availability of macroscopic amounts of this material allows for the production of electronic devices such as photoelectric cells (15:46-16:2). It has been held that where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re

Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (MPEP 2144.05).

6. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono and Wang as applied to claim 6 above, and further in view of Tanaka et al. (US 2003/0179537).

The teachings of Ono and Wang as discussed above are herein incorporated.

Regarding claims 40 and 41, Ono and Wang are silent towards the size of the carbon fibers or carbon black.

Tanaka teaches a method for producing carbon materials such as carbon fibers and pulp where the diameters are between 2 to 500nm and with an aspect ratio of 10 to 15000 [0024-0026]. It would have been obvious to one of ordinary skill in the art at the time of the invention to carbon particles in the nanoparticle range because Tanaka teaches a method to produce them.

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ono, Wang, and Smalley et al. as applied to claim 7 above, and further in view of Smalley et al. (US 2002/0085968, hereinafter referred to as Smalley '968).

The teachings of Ono, Wang, and Smalley as discussed above are herein incorporated.

Regarding claim 43, Ono, Wang, and Smalley are silent towards the use of multi-walled nanotubes.

Smalley '968 teaches that carbon nanotubes that are formed may also be multi-walled nanotubes [0068] for a photoelectric element [0207-0208] having a diameter of 3nm to 100nm and lengths from 50nm to 5cm or greater [0064]. It would have been obvious to one of ordinary skill in the art at the time of the invention to use multi-walled nanotubes for a photoelectric element because Smalley teaches when nanotubes are formed they include both single-wall and multi-walled nanotubes which can be used for a photoelectric element. It has been held that where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (MPEP 2144.05).

Response to Arguments

8. Applicant's arguments filed May 5, 2010 have been fully considered but they are not persuasive.

Applicant's principal arguments are:

(a) Wang does not disclose gelation by using conductive particles containing carbon as the main component and does not disclose that the electrolyte solution can be in the form of a gel by the action of the conductive particles.

In response to Applicant's arguments, please consider the following comments:

(a) As discussed in the rejection above, there is recognition by the Wang reference that a photoelectric device with submicrometer sized particles including graphite particles

(particles containing carbon as the main component) can act as a "gelator" within an ionic liquid (electrolyte). It would have been obvious and well within the skill of one of ordinary skill in the art to provide the conductive particles of Ono within a submicron range since Wang recognizes submicron carbon particles can act as a gelator within an ionic liquid.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact/Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwang Han whose telephone number is (571) 270-

5264. The examiner can normally be reached on Monday through Friday 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on (571) 272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. H./
Examiner, Art Unit 1727

/Dah-Wei D. Yuan/
Supervisory Patent Examiner, Art Unit 1727